

REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-32 are presented for examination. Claims 1-3, 9-19, and 23-25 have been amended to clarify that the claimed server device is included as part of a set top box (STB) and to correct minor grammatical errors without the introduction of any new matter. See, for example, the specification at page 17, lines 4-7.

The outstanding Office Action presents a rejection of Claims 1 and 3-18 under 35 U.S.C. § 102(b) as being anticipated by Crawford (U.S. Patent No. 5,771,354) and a rejection of Claims 2 and 19-32 under 35 U.S.C. § 103(a) as being unpatentable over Crawford in view of Internet Explorer (web browser, copyright 1991-2001).

Before discussion the outstanding prior art rejections, it is again believed that the brief review of the present invention set forth in the last response would be helpful. In this regard, and as noted in the last response, the present invention is directed to a game machine system that allows a user to enjoy games according to supplied game software in their own home at a low cost. The game machine system provides a game machine that can execute gaming commands, a set top box (STB) that serves as a server device, and a television receiver serving as a display device. These three basic elements of the game machine system are connected to each other via a digital communication line that is external to each of these devices. The STB server receives game software transmitted to it via digital broadcasting services and stores received game software on a hard disk internal thereof. The game machine can then execute a game by accessing the hard disk to read the game software as required. The image generated by the game machine and background image data output from

the STB server are supplied to the display television receiver via the digital communication line so that a game image including background can be displayed and the game played.

Turning to the outstanding rejection of Claims 1 and 3-18 as being anticipated by Crawford, it is again noted that Figure 3 of Crawford shows a device 104, internal to on-line service system 100, characterized in the outstanding Action as the claimed server device. However, 104 is described by Crawford to be a host computer (an IBM AS/400 as noted at col. 16, lines 9-10) that is inside the on-line service system 100. As explained in the abstract of Crawford, for example, the data link 150 between the host computer 104 in the on-line service system 100 and the customer computer is a phone line or Internet and there is no reasonable way to interpret the host computer 104 as being included as part of an STB as claimed.

Moreover, and as noted in the last response and above, the host computer 104 in the on-line service system 100 of Crawford is asserted in the outstanding Action to read as the claimed "server device," the display monitor 54 of Crawford is asserted to read as the claimed "display device" and the Crawford processor 68, internal of computer 50 that also clearly houses display monitor 54, is asserted to read as the claimed "game executing device." The communications lines 150 of Crawford are then asserted to read on the claimed "digital communication line that is external to the server device, the display device, and the game executing device" because 150 is external to the on-line service system 100 and the customer computer 50 as noted at page 2 of the Action.

However, independent Claims 1, 9, and 14 do not just recite that the digital communication line must be external to the server device, the display device, and the game executing device. Instead, each of these independent claims recite that the "server device,"

Appl. No. 09/697,554  
Reply to Office Action of February 5, 2003

the “display device,” and the “game executing device” are “connected to each other via a digital communication line that is external to the server device, the display device, and the game executing device” (emphasis added).

If the PTO finds a teaching in Crawford that the processor 68, internal of computer 50, is connected to the display monitor 54, also internal of computer 50, by the communications lines 150, despite the showings of Figs 1 and 3 and the admission at page 6 of the outstanding Action that communication line 150 cannot connect internal portions 68 and 54 together because it is external to computer 50 housing these elements, it must point to where in Crawford it finds this teaching. See In re Rijckaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (“When the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference.”).

On the other hand, if the PTO is simply ignoring these words of independent Claims 1, 9, and 14, it does so in violation of court precedent it is required to follow. See In re Wilson, 165 USPQ 494, 496 (CCPA 1970) (“All words in a claim must be considered in judging the patentability of that claim against the prior art.”).

Moreover, not only do independent Claims 1, 9, and 14 include these above-noted words that require the “display device,” and the “game executing device” to be “connected to each other” (emphasis added) via a digital communication line that is external to these elements and the “server device,” so do Claims 3-8, 10-13, and 15-18. This is because these claims ultimately depend from one or the other of independent Claims 1, 9, and 14 and, thus, include the above-noted limitations of these independent claims that are clearly not taught or suggested by Crawford. In addition, these dependent Claims 3-8, 10-13, and 15-18 all include

Appl. No. 09/697,554

Reply to Office Action of February 5, 2003

additional recitations that are not taught or suggested by Crawford and, accordingly, cannot be said to be anticipated by Crawford for this reason as well.

Furthermore, and as noted in the last response, the outstanding Action again inappropriately attempts to lift the description of the prior art at column 2, lines 15 and 16 and transpose it into the disclosure of the Crawford system of Figs. 1 and 3 without any statement by Crawford that the download of new video games provided by the noted information providers is to be incorporated into the improved and different on-line service that Crawford proposes. The Crawford teaching is of a system for "executing host based software on the remote user's system directly or for a user's locally executing application to directly access storage on the host system," see col. 7, lines 56-60, with no mention that the downloading of video games is to be included in the Crawford system to be found here or elsewhere in Crawford.

In this last regard, the question is not the "obviousness" under 35 U.S.C. §103 of adding the downloading of new video as noted relative to previous service providers to the Crawford taught system, it is instead where the Crawford teaching of inclusion of video game downloading as a part of the Crawford system can be found in Crawford. Thus, the mere mention of a video game downloading service as a previously provided service is still not seen to be a teaching that this service is to be included in the system proposed by Crawford.

This argument is based on the established case law that requires anticipation by a single reference that shows the claimed subject matter in the claimed arrangement that was noted in the last response relative to In re Bond, 15 USPQ2d 1566 (Fed. Cir. 1990); Ex parte Gould, 6 USPQ2d 1680 (Bd. Pat. App. & Int. 1987); and Ex parte Osmond, 191 USPQ 334 (Bd. Pat. App. & Int. 1973). Clearly, what Crawford teaches to be included into the system

Appl. No. 09/697,554  
Reply to Office Action of February 5, 2003

and available for a fee is the question that must be addressed as to anticipation and not whether the artisan would have been motivated to include downloading of video game software as done by other providers, a different question under 35 U.S.C. §103 that requires that evidence of motivation must also be shown.

Accordingly, the anticipation rejection applied to Claims 1 and 3-18 is traversed for all the above-noted reasons.

Turning to the obviousness rejection of Claims 2 and 19-32, it is noted that the Internet explorer browser software is again relied upon for the inclusion therein of the Joint Picture Expert Group (JPEG) image format which is once more simply alleged in the Action to have been developed at least as early as 1997.

The present outstanding action suggests that an "Examiner's Affidavit dated 27 June 2002" was attached to the previous Action that was not mailed until September 3, 2002. However, no "Examiner's Affidavit dated 27 June 2002" was attached to the copy of the Action mailed September 3, 2002, received by Applicant. Moreover, no mention of any "Examiner's Affidavit dated 27 June 2002" appears in this September 3, 2002, Action and no indication of such an attachment appears on the "Office Action Summary" that was mailed with that Action even though this Summary includes an "Attachment(s)" portion including an "other" block 6 to be checked when non-standard attachments are included. Thus, to the extent that the rejection of Claims 2 and 19-32 under 35 U.S.C. §103 relies on the "Examiner's Affidavit dated 27 June 2002" to establish the date of the Joint Picture Expert Group (JPEG) image format and/or the fact of its actual inclusion with Internet Explorer (web browser, copyright 1991-2001), it is improper and traversed for failing to provide Applicant a signed copy thereof.

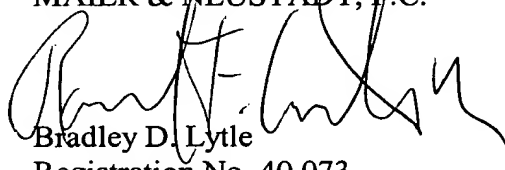
Appl. No. 09/697,554  
Reply to Office Action of February 5, 2003

In addition, there is nothing alleged in the outstanding Action as to the Joint Picture Expert Group (JPEG) image format and/or the Internet Explorer (web browser, copyright 1991-2001) that cures any of the deficiencies noted above as to Crawford. Accordingly, as each of Claims 2 and 19-32 also requires the above-noted server device to be included as part of a set top box (STB) as well as a digital communication line that is external the "display device," the "game executing device," and the "server device" yet serves to connect each one of these devices "to each other" (emphasis added), and as there has been no presentation of any evidence showing this claim structure and corresponding claim steps, this rejection of Claims 2 and 19-32 is traversed as lacking establishment of the required *prima facie* showing of obviousness.

Accordingly, as no other objections or rejections remain outstanding, it is believed that this application is clearly in condition for formal allowance and an early and favorable action to this effect is, therefore, respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



Bradley D. Lytle  
Registration No. 40,073  
Attorney of Record  
Raymond F. Cardillo, Jr.  
Registration No. 40,440.

Customer Number

22850

Tel.: (703) 413-3000

Fax: (703) 413-2220

GJM:RFC\jmp

I:\atty\rfc\202721-am2.wpd